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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,694	07/09/2003	Sharlene Adams	10248.70023US00	1643

7590 12/05/2005
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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,694

Applicant(s)

ADAMS ET AL.

Examiner

David Lukton

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13 and 164 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims:

Claims pending in the application are 1-13,40,44,61,77,94,112,129,164,172,192,198,267,276,281,283,287,290,294,299,309,362-364,405,437 and 467.

Continuation of Disposition of Claims:

Claims withdrawn from consideration are 1-12,40,44,61,77,94,112,129,172,192,198,267,276,281,283,287,290,294,299,309,362-364,405,437 and 467.

Claims 1-13, 40, 44, 61, 77, 94, 112, 129, 164, 172, 192, 198, 267, 276, 281, 283, 287, 290, 294, 299, 309, 362-364, 405, 437, 467 remain pending.

Applicants' election of Group 2 (claims 13 and 164) is acknowledged. Also acknowledged is applicants' initial attempt to elect a specific compound. Applicants have elected the genus of compounds in which $m = 0$, A_1 is L-Proline, the isoleucine residue is in the L-configuration, and "R" can be any "organoborate" of any size, shape or description. The term "organoborate" could include, for example, a decapeptide that contains a boron atom somewhere. Election of a specific "R" group is required; alternatively applicants can make an admission that all organoborate groups are obvious over all other organoborate groups.

Further elections are required as indicated below.

Applicants are required under 35 U.S.C. §121 to elect disclosed species (as follows) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

- a) one of the following: the infectious disease is bacterial, mycobacterial, viral, fungal or parasitic;
- b) (i) in the event that the disease is bacterial, election of a specific bacteria is required

(e.g., staphylococcus);

(ii) in the event that the disease is mycobacterial, election of a specific mycobacteria is required (e.g., *M. tuberculosis*);

(iii) in the event that the disease is viral, election of a specific virus is required (e.g., hepatitis A);

(iv) in the event that the disease is fungal, election of a specific fungus is required (e.g., aspergillosis);

(v) in the event that the disease is parasitic, election of a specific parasite is required (e.g., schistosomiasis).

c) one of the following: (i) the agent of formula I is administered by injection, or (ii) the agent of formula I is administered in enterically coated form;

d) one of the following: (i) the compound of formula I is administered without another active agent being present, or (ii) the compound of formula I is administered in a composition that contains another active agent such as an antibiotic or antifungal or antiviral or anti-parasitic agent; and

e) the contents of the composition that is administered.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached at (571)272-0974. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



**DAVID LUKTON
PATENT EXAMINER
GROUP 1800**